

Applic. No. 09/852,348
Amdt. dated April 7, 2005
Reply to Office action of January 7, 2005

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 6, 8, 9, 10-12, and 14-25 remain in the application.

In item 4 on page 2 of the above-noted Office action, claims 6, 12, and 20-23 have been rejected as being obvious over Boss et al. (U.S. Patent No. 6,142,353) (hereinafter "Boss") in view of Raffoni (U.S. Patent No. 6,220,494 B1) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 20 calls for, *inter alia*:

an ejector adapted for operatively oscillating in parallel with the conveying strand for running in synchronicity with the conveying strand in the conveying direction within certain

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time segments and for operatively oscillating between the conveying strand and the delivery within a path rectilinear to the conveying strand within certain time segments.

As previously discussed, the Boss reference discloses a gathering stapler with a common drive for which the motion of the individual components is obtained by using interconnected corresponding gear units. There is no disclosure or suggestion in Boss concerning the use of separate drives for the individual components.

The only commonality between the invention of Boss and the present invention is that both are gathering staplers. Furthermore, it is known to a person of ordinary skill in the art that gathering staplers run at speeds in excess of 14,000 cycles per hour. This high speed is one of the most important reasons that the synchronization of the individual components is of the utmost importance. A crash at such high speeds would cause great damage to the product handled by the stapler and might even damage the stapler itself. Therefore, a person of ordinary skill in the art knows that synchronization must be extremely precise and is unlikely to stray from a mechanical interconnection of the individual components.

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The Raffoni reference discloses a device for manufacturing picture frames. The operation of with is entirely different than that of the present invention. The device disclosed by Raffoni hardly comes close to the production velocities required by a gathering stapler. Therefore, because of the considerable difference in the two technologies, a person of ordinary skill in the art of gathering staplers would not consider the teaching of a device for making picture frames, as disclosed by Raffoni.

The Examiner stated that Raffoni teaches an ejector, namely a conveyor downstream of belt (2). This is shown in Fig. 5 of Raffoni as a turntable (41) or a conveyor (43).

However, claim 20 of the instant application recites an ejector adapted for operatively oscillating in parallel with the conveying strand for running in synchronicity with the conveying strand in the conveying direction within certain time segments and for operatively oscillating between the conveying strand and the delivery within a path rectilinear to the conveying strand within certain time segments.

The Raffoni reference does not disclose any oscillation motion or perpendicular motion (up/down) of the turntable to a

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conveying strand. The turntable of Raffoni is not an ejector as recited in claim 20 of the instant application.

Claim 20 calls for, *inter alia*:

a stapling carriage assigned to the conveying strand and operatively oscillating in parallel with the conveying strand for running in synchronicity with the conveying strand in the conveying direction within certain time segments.

The Raffoni reference does not disclose any oscillating motion of a carriage. The Raffoni reference does not disclose a carriage running in synchronicity with a conveying strand.

Raffoni does not disclose the use of a motor to actuate the conveyor. Furthermore, Raffoni is silent about the feature of "time segments" as well. Also, Raffoni is silent about the synchronicity of individual components.

Although Raffoni may disclose some common features of the claimed invention, namely a staple head, the use of drives in Raffoni would not provide motivation for a person of ordinary skill in the art to modify Boss.

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A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance,

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160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998);
In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir.
1984) .

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed

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on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61
USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Based on the above provided comments, it is applicants' position that there is no connection between Boss and Raffoni, likewise a person of ordinary skill in the art is not given any motivation to combine Boss and Raffoni.

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In item 4 on page 3 of the above-noted Office action, claims 8, 10, 11, and 14 have been rejected as being obvious over Boss (U.S. Patent No. 6,142,353) in view of Raffoni (U.S. Patent No. 6,220,494 B1) and further in view of Dunn (U.S. Patent No. 5,816,467) under 35 U.S.C. § 103. Dunn does not make up for the deficiencies of Boss and Raffoni. Since claim 20 is believed to be allowable, dependent claims 8, 10, 11, and 14 are believed to be allowable as well.

In item 6 on page 4 of the above-noted Office action, claims 21, 22, 24, and 25 have been rejected as being obvious over Boss (U.S. Patent No. 6,142,353) in view of Dunn (U.S. Patent No. 5,816,467) under 35 U.S.C. § 103. It is noted that claim 20 was rejected using Raffoni in addition to Boss. Therefore, it is not seen how claims 21, 22, 24, and 25 can be rejected without Raffoni. Nevertheless, Dunn does not make up for the deficiencies of Boss. Since claim 20 is believed to be allowable, dependent claims 21, 22, 24, and 25 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 20. Claim 20 is, therefore, believed to be patentable over the art and since

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all of the dependent claims are ultimately dependent on claim
20, they are believed to be patentable as well.

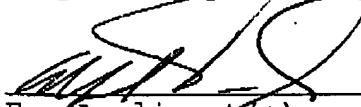
In view of the foregoing, reconsideration and allowance of
claims 6, 8, 9, 10-12, and 14-25 are solicited.

In the event the Examiner should still find any of the claims
to be unpatentable, counsel respectfully requests a telephone
call so that, if possible, patentable language can be worked
out.

If an extension of time for this paper is required, petition
for extension is herewith made.

Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &
Greenberg P.A., No. 12-1099.

Respectfully submitted,



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April 7, 2005

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